

**REMARKS**

I. Status of the Claims

Claims 1-55 are pending in this application. Claims 30, 42, and 48-51 have been amended to further clarify the scope of the invention in light of the Examiner's suggestions. Applicant has also amended Claim 41 to correct an inadvertent typographical error. Applicant has also amended Claims 1 and 45 to remove certain species of cationic direct dyes, by proviso, specifically to ensure the claims do not encompass compositions that may have been previously disclosed. Applicant submits that such provisos are fully supported as described below and, therefore, that no new matter has been added by this amendment.

Applicant believes that the additional provisos now recited in the claims are fully supported by the specification as filed. Applicant is simply claiming less than the full scope of her disclosure—a perfectly legitimate exercise since it is for the inventor to decide what bounds of protection she will seek. Moreover, Applicant respectfully submits that *In re Johnson*, 194 USPQ 187 (C.C.P.A. 1977) provides legal precedent for the addition of these provisos.

The fact pattern in the present case is analogous to the fact pattern in *Johnson*. As in *Johnson*, Applicant is including provisos in the claims that exclude certain components that may have been taught by the prior art. Additionally, in *Johnson* and in the present case, a broad and generic disclosure of the excluded components is set

forth: In *Johnson*, a broad class of precursor compounds with specific examples was disclosed; in the present specification, broad classes of cationic direct dyes, including specific examples, were disclosed. Based on these common underlying factors, Applicant respectfully submits that *Johnson* is analogous to the present case.

The holding in *Johnson* is not limited to permitting only the exclusion of compositions which have been specifically recited in the specification. Rather, *Johnson* requires that a "broad and complete generic disclosure, coupled with extensive examples fully supportive of the limited genus now claimed" must be present to support the exclusion of specific compositions. *In re Johnson*, 194 USPQ at 196.

Applicant respectfully submits that a broad and complete generic disclosure is set forth in this application. Each of the thickening polymers were fully defined in the specification as originally filed. Additionally, the numerous ready-to-use dyeing compositions comprising at least one cationic direct dye and at least one thickening polymer set forth in the specification and recited in the claims encompass a wide variety of compositions which are representative of the entire range of compositions set forth in the claims. Thus, the specification and claims as originally filed set forth specific compositions that are not excluded by the new provisos recited in the claims. As in *Johnson*, this fact provides sufficient evidence that Applicant considered the subject

matter of the presently claimed invention to be within the scope of her invention, and the new provisos are not new matter for this reason alone.

Moreover, adequate written description, particularly with respect to provisos, does not require literal support for the claimed invention. *In re Wertheim*, 191 USPQ 90, 98 (CCPA 1976). The originally filed disclosure provides support as long as it would have reasonably conveyed to one having ordinary skill in the art that an applicant had possession of the concept of what is now claimed. *In re Anderson*, 176 USPQ 331, 336 (CCPA 1973).

One case often cited by the U.S. Patent and Trademark Office in response to an amendment limiting the scope of a claim in view of prior art differs from the present situation. In *Ex parte Grasselli*, 231 USPQ 393, 394 (Bd. Pat. App. 1983), the claim at issue related to a process for the ammoxidation of propane or isobutane comprising using a catalyst described in a certain formula. At the end, the claim recited that the catalyst was free of uranium and the combination of vanadium and phosphorus. The formula, however, did not originally cover uranium. Thus, the applicant sought to exclude uranium from the catalyst, but uranium was not a species falling within the genus of the recited catalytic formula. The applicant urged that the catalyst recited in the claims was open to inclusion of all other elements not expressly included by the negative limitation. The Board held that there was no written description for the negative limitation.

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

The *Grasselli* facts sharply contrast with the present facts. In *Grasselli*, uranium was never covered by the original genus. In the present case, Applicant seeks nothing more than to proviso out of the claims certain compositions comprising certain species of cationic direct dyes combined with certain species of thickening polymers from the compositions, all of which fall within the original genus of compositions defined.

Although *Grasselli* is not applicable, Applicant falls directly within the rationale of *Wertheim*. According to the *Wertheim* court, ruling that the entire genus is not patentable because the applicant erroneously thought he was the first to invent the genus of compounds would exalt form over substance. *In re Wertheim*, 191 USPQ at 97. The situation in *Grasselli*, in contrast, involved introducing a new concept, *i.e.*, uranium. The present situation, like that in *Wertheim*, does not involve a new concept. Rather, the present situation involves something within the originally claimed genus that is simply being excised to overcome the prior art. *Wertheim* approved that approach, and the Examiner has no reason to treat Applicant any differently.

Additionally, as the Board of Patent Appeals & Interferences stated in *Ex parte Parks*, 30 USPQ2d 1234, 1236 (BPAI 1994), the decision in *Grasselli* involved claims that contained a negative limitation that introduced new concepts in violation of 35 U.S.C. § 112, first paragraph. *Parks* was like *Grasselli* in that the claim recited a negative limitation, specifically "in the absence of a catalyst." The proviso in *Parks* did not involve a situation where a species/subgenus of an original genus constituted the

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

subject matter of the proviso. Nonetheless, the Board in *Parks* found written description support, proving that *Grasselli* is not a general rule applicable to all cases.

Finally, Applicant respectfully submits that the specification as filed would also be fully supportive of the compositions comprising certain species of cationic direct dyes in combination with certain species of thickening polymers sought to be excluded by the provisos added to the claims. Applicant respectfully submits that these compositions would have been apparent to one of ordinary skill in the art after reading the present specification. The specification discloses the radicals necessary to arrive at the species of cationic direct dyes as well as the species of thickening polymers, and the specific compositions disclosed in the specification and claims as originally filed contain both the individual dye compounds and the individual thickening polymers sought to be excluded, when combined, from the claimed compositions.

Because the specification discloses the combination of radicals that would have resulted in the excluded species of thickening polymers, when combined with certain species of cationic direct dyes, the excluded compositions would have been apparent to the skilled artisan after reading the specification as filed. Thus, the present specification is also fully supportive of the species of compositions sought to be excluded by the provisos recited in the claims.

Accordingly, the provisos added to the claims have introduced no new concepts; they merely exclude combinations of certain species from the original genres. As

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

explained above, *Grasselli* does not control the present situation, wherein Applicants utilize a proviso to exclude subject matter originally within the genus of the claim. Instead, because *Wertheim* and *Johnson* control, no new matter has been added by this amendment. The relevant case law, therefore, dictates that the provisos recited in the claims find support in the specification.

II. Double Patenting Rejections

Claims 1-17 and 21-25 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 09/349,436.

Claims 1-55 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23, 31, 54-82, 84-87, 90-107 of copending Application No. 09/350,579.

Claims 1-21 and 25-55 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 and 17-42 of copending Application No. 09/287,176.

Applicants disagree and traverse all of these rejections. At this time, however, Applicants respectfully request that the rejections be held in abeyance until allowable subject matter is indicated in this application.

III. Rejection under 35 U.S.C. § 112

Claims 30-31, 42, 45, and 48-51 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out distinctly and claim the subject matter which applicant regards as the invention for the reasons set forth on page 4 of the Office Action.

To address the rejection of Claims 30 and 31, Applicant has amended Claim 30 to read "at least one additional direct dye, different from said at least one cationic direct dye (i) as defined in Claim 1." Support for this amendment can be found, e.g., at page 34, lines 5-9 of the original specification as filed. Applicants respectfully assert that this clarification also acts to clarify Claim 31, which is dependent on Claim 30.

To address the rejection of Claim 42, Applicant has amended Claim 42 to further clarify that when the claimed composition is intended for lightening direct dyeing, the at least one cationic direct dye and the at least one thickening polymer are present in a combined amount sufficient for said lightening direct dyeing. Support for this amendment is found, e.g., at page 36, lines 14-15. Applicants also assert that "lightening direct dyeing" is clearly defined in the original specification as filed at page 1, lines 8-17.

Further, in response to the rejection of Claim 45, Applicant has amended Claim 45 to read "at least one dye composition," thus removing the reference to oxidation dyeing. Support for this amendment can be found at e.g., page 37, lines 3-4.

Finally, in response to the last point of rejection, Applicant has amended Claims 45 and 48-51 to read "a desired coloration," instead of "the desired coloration."

In view of the above amendments, all points of rejection under § 112, 2nd paragraph, have been overcome and Applicant respectfully requests that the rejections be withdrawn.

IV. Rejection under 35 U.S.C. § 102(e)

Claims 1-17, 25-29, 32-34, and 38-47 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Rondeau et al.* (U.S. Pat. No. 6,001,135). The Examiner points to Example 2 of *Rondeau et al.* alleging that it illustrates a composition comprising, in three parts, an oxidation base, a cationic direct dye of formula (I1), sawdust which comprises polymers containing a sugar unit as claimed (cellulose), and the oxidant hydrogen peroxide. Applicant respectfully traverses this rejection.

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). In the present case, the Examiner has failed to show that the claimed subject matter as amended is identically described or disclosed in the prior art.



Finally, in response to the last point of rejection, Applicant has amended Claims 45 and 48-51 to read "a desired coloration," instead of "the desired coloration."

In view of the above amendments, all points of rejection under § 112, 2nd paragraph, have been overcome and Applicant respectfully requests that the rejections be withdrawn.

IV. Rejection under 35 U.S.C. § 102(e)

Claims 1-17, 25-29, 32-34, and 38-47 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Rondeau et al.* (U.S. Pat. No. 6,001,135). The Examiner points to Example 2 of *Rondeau et al.* alleging that it illustrates a composition comprising, in three parts, an oxidation base, a cationic direct dye of formula (I1), sawdust which comprises polymers containing a sugar unit as claimed (cellulose), and the oxidant hydrogen peroxide. Applicant respectfully traverses this rejection.

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). In the present case, the Examiner has failed to show that the claimed subject matter as amended is identically described or disclosed in the prior art.

*Rondeau et al.* relates to a ready-to-use composition for the oxidation dyeing of keratin fibers which comprises at least one oxidation base in combination with at least one selected cationic direct dye and at least one oxidizing agent. See col. 1, lines 25-30. *Rondeau et al.* also relates to a process for dyeing keratin fibers using the ready-to-use composition. See col. 22, lines 49-51. According to one preferred embodiment, the process includes a preliminary step which involves separately storing a composition (A') comprising at least one cationic direct dye and a composition (B) containing, in a medium which is suitable for dyeing, at least one oxidizing agent as defined, and mixing them together at the time of use before applying this mixture to the keratin fibers. See col. 23, lines 4-16.

The composition (A') used according to this second variant of the process can optionally be in powder form, the cationic direct dye(s) optionally being dispersed in an organic and/or inorganic pulverulent excipient. See col. 23, lines 16-23.

Example 2, cited by the Examiner, recites a Composition (2A) comprising para-toluylenediamine sulphate (at least one oxidation base), Composition (2A') comprising a cationic dye of structure (I14), quarternary polyammonium and sawdust (an organic pulverulent excipient), and Composition (B) containing hydrogen peroxide (at least one oxidizing agent). See Example 2, col. 24, lines 45-67.

The Examiner alleges that sawdust comprises polymers containing a sugar unit as claimed, i.e. cellulose. However, the sawdust in *Rondeau et al.* is hardly what

Applicant intended to cover by the term, and is not in fact what is typically meant in the art by, "thickening polymer." Rather, one of ordinary skill in the art would recognize that the sawdust of *Rondeau et al.* is a mixture of both polymeric and non-polymeric components, specifically a mixture composed of 67-80% holocellulose and 17-30% lignin (a phenylpropane polymer), together with low percentages of resins, sugars, a variable amount of water and potassium compounds.<sup>1</sup> The term "thickening polymer" is therefore not intended to encompass sawdust.

In order to anticipate the claimed invention, *Rondeau et al.* must clearly and unequivocally disclose the claimed composition to one of ordinary skill in the art "without any need for picking, choosing and combining various disclosures." *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). In the present case, *Rondeau et al.* exemplifies a composition comprising at least one cationic direct dye according to the presently claimed invention. However, this composition fails to exemplify at least one thickening polymer as defined in the present application. In fact, *Rondeau et al.* only discloses organic and/or inorganic pulverulent excipients which can optionally be added to powdered compositions (A') used according to a specific variant of one process disclosed in the patent. See col. 23, lines 4-24.

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

---

<sup>1</sup> See Richard J. Lewis, Sr., *Hawley's Condensed Chemical Dictionary*, John Wiley & Sons, 1997.

Thus, in order for one of ordinary skill in the art to attempt to arrive at the presently claimed invention, the skilled artisan would need to "pick and choose" the specific process containing composition (A'), "pick and choose" composition (A') therein to be in powdered form, "pick and choose" the powdered composition (A') to be dispersed in a pulverulent excipient, "pick and choose" the pulverulent excipient to be organic, and finally, "pick and choose" the organic pulverulent excipient to be a thickening polymer as defined in the present application i.e, other than sawdust. Not only is picking and choosing of this sort inappropriate under § 102, *Rondeau et al.* actually teaches away from using excipients other than sawdust, by teaching sawdust as preferred. See, e.g., col. 23, lines 35-36. Because picking and choosing would be needed to arrive at the composition recited in present claim 1, *Rondeau et al.* fails to anticipate the claimed invention. Further, *Rondeau et al.* does not "identically describe or disclose" Applicant's invention, therefore, Applicant respectfully requests that the rejection under § 102(e) be withdrawn.

V. Rejection under 35 U.S.C. § 103(a)

**Rondeau et al.**

Claims 1-55 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rondeau et al.* for the reasons set forth on pages 6-7 of the present Office Action.

The Examiner asserts that *Rondeau et al.* "teaches the equivalence between the exemplified sawdust and various other sugar-containing polymers as claimed." The Examiner acknowledges, however, that *Rondeau et al.* does not exemplify a composition which contains each claimed component in the claimed amounts, particularly the specifically claimed polymers, nor does *Rondeau et al.* teach specifically the various claimed hair dyeing processes and kits. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to formulate a composition for dyeing hair which contains a cationic direct dye, oxidation base, coupler and additional dyes as claimed, wherein each component is present in the claimed amounts, wherein the composition may be applied to hair in processes as claimed and may be packaged in multi-part kits, because such compositions, processes and kits allegedly fall within the scope of those taught by *Rondeau*. The Examiner further contends that "it would have been obvious to those skilled in the art to substitute the sawdust excipient in *Rondeau's* Example 2 with a polymer as claimed, e.g. a cellulose or gum derivative, because the patentee teaches the equivalence between such excipients for use in the patentee's compositions." Applicants disagree, and therefore respectfully traverse this rejection for the reasons stated above as well as the following reasons.

To establish a *prima facie* case of obviousness, an Examiner must meet three basic criteria. First, he or she must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

available to one of ordinary skill in the art, to modify a reference or combine reference teachings. Second, an Examiner must demonstrate that there was a reasonable expectation of success. Finally, the prior art reference(s) must also teach or suggest all the claim limitations. See M.P.E.P. § 2143. Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In the present case, the Examiner has failed to make a *prima facie* case of obviousness because at least the first two of the above criteria have not been met.

One of skill in the art would not have been motivated to form the presently claimed compositions on the basis of *Rondeau et al.* As previously mentioned, in order for one of ordinary skill in the art to attempt to arrive at the presently claimed invention, the skilled artisan would need to (1) "pick and choose" a specific process, (2) "pick and choose" composition (A') therein to be in powdered form, (3) "pick and choose" the powdered composition (A') to be dispersed in a pulverulent excipient, (4) "pick and choose" the pulverulent excipient from organic pulverulent excipients as defined by *Rondeau et al.*, and finally, (5) "pick and choose" this organic pulverulent excipient to be a thickening polymer as defined in the present application from pulverulent excipients of (a) synthetic and (b) plant origin and further select from: (c) crosslinked and (d) non-crosslinked synthetic polymers, (e) polysaccharides such as celluloses and modified or unmodified starches, as well as (f) natural products containing them such as sawdust

and plant gums. Thus, a grand total of at least 6 separate and distinct choices would be required, each and every one needed to arrive at a polymer within the scope of the instant thickening polymers, and none of which are motivated by *Rondeau et al.*

Applicant notes that not one example in *Rondeau et al.* comprises the "cellulose or gum derivative[s]" which the Examiner claims would be obvious to substitute for sawdust.

Without guidance, suggestion or motivation, Applicants submit that the instant thickening polymers would not have been obvious to one of skill in the art. In fact, as discussed above, *Rondeau et al.* actually teaches that sawdust is preferred, so there certainly would have been no motivation to substitute anything else for the sawdust as excipient.

Further, even if one did make the substitution suggested by the Examiner, there would have been no reasonable expectation of success. The present application teaches ready-to-use compositions comprising (1) at least one cationic direct dye chosen from compounds of formulae (I), (II), (III) and (III') and (2) at least one thickening polymer comprising at least one sugar unit. In contrast, *Rondeau et al.* teaches ready-to-use compositions comprising (1) at least one oxidation base, (2) at least one cationic direct dye, and (3) at least one oxidizing agent. Therefore, *Rondeau et al.* requires both at least one oxidation base and at least one oxidizing agent, neither of which are required by broad claim 1. Accordingly, one of ordinary skill in the art would not necessarily have expected success from substitution of a pulverulent excipient with a thickening agent of the present application in *Rondeau et al.* without including either at

least one oxidation base or at least one oxidizing agent. To establish a *prima facie* case of obviousness, an Examiner must demonstrate that there was a reasonable expectation of success. See M.P.E.P. § 2143. Thus, in the present case, a *prima facie* case of obviousness has not been established.

Further, the motivation to modify *Rondeau et al.* by adding at least one thickening polymer of the present application and removing two required ingredients (oxidation base and oxidizing agent) simply does not exist in the cited reference. Yet, the M.P.E.P. requires that the motivation to modify the disclosures of *Rondeau et al.* to obtain the claimed composition must come from the references themselves. See M.P.E.P. § 2143 (7<sup>th</sup> ed. 1<sup>st</sup> rev. 2000); *see also In re Dembiczak*, 175 F.3d 999, 50 USPQ2d 1614 (Fed. Cir. 1999). This has not occurred here.

Additionally, even if, *arguendo*, *Rondeau et al.* did teach the equivalence between the sawdust excipient in *Rondeau et al.*'s Example 2 with particular polymers which were encompassed by the at least one thickening polymer of the present application ("a polymer as claimed, e.g. a cellulose or gum derivative" see page 7 of the present Office Action), the equivalence between the compounds is taught for a different purpose, that is, the compounds are merely taught as equivalent excipients - not as thickening polymers. *Rondeau et al.*'s organic pulverulent excipient is just that, that is, "an inert



substance used as a diluent or vehicle for a drug" (excipient<sup>2</sup>) "made of, covered with, or crumbling to fine powder or dust" (pulverulent<sup>2</sup>). In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on Applicants' disclosure or the mere fact that the components at issue are functional or mechanical equivalents. See *In re Ruff*, 356 F.2d 590, 118 U.S.P.Q. 340 (CCPA 1958) ("The mere fact that components are claimed as members of a Markush group cannot be relied upon to establish the equivalency of these components."). The prior art relied on by the Examiner for a rejection under § 103(a) on page 6 of the present Office Action, namely *Kao Corporation*, expressly teaches the inequivalence of various members of the exemplified at least one thickening polymers of the present application as thickeners in dye compositions. See page 4, lines 56-59 of *Kao Corporation*. Therefore, the prior art of record does not teach the equivalence of cellulose and gum derivatives as thickening agents, but, in contrast, teaches their inequivalence. The Examiner has provided no other prior art indicating the equivalence of these compounds as thickening polymers, and therefore has failed to establish both this equivalence and a *prima facie* case of obviousness.

Therefore, because the *Rondeau et al.* patent teaches the use of different chemical compounds to form a different product via a different method for a different

---

<sup>2</sup> *The American Heritage College Dictionary (Third Edition)*, Houghton Mifflin Company, Boston, 2000.

purpose, one of ordinary skill in the art would not have been motivated to modify *Rondeau et al.* to obtain the present inventive compositions, nor would there have been a reasonable expectation of success. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

**Kao Corporation**

Claims 1-9, 12-17, 22-31, 42 and 44-47 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kao Corporation* (EP 756,861). The Examiner asserts that *Kao Corporation* "teaches compositions for dyeing hair containing at least one direct dye, and a C<sub>2-4</sub> hydroxyalkyl guar gum in the claimed amounts, wherein preferred guar gum includes the claimed nonionic hydroxypropyl guar gum, see page 2, lines 17 and 25-27." See page 7 of the Office Action. The Examiner directs Applicant to "[n]ote the examples, particularly example 1 which uses hydroxypropyl guar in combination with cationic dyes, and example 2 which uses a cationic hydroxypropyl guar in combination with a basic red dye." See pages 7-8 of the Office Action. The Examiner acknowledges, however, that *Kao Corporation* does not exemplify a composition which contains at least one cationic dye as claimed. See page 8 of the Office Action.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art to formulate a composition for dyeing hair which contains Basic Red 22,

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

additional direct dyes, and a modified guar gum thickener as claimed, reasoning that it would be obvious to at least partially substitute the cationic dyes in Kao's examples with Basic Red 22 as claimed, resulting in dyeing compositions and processes as claimed, because *Kao Corporation* teaches the equivalence between Basic Red 22, which falls within the scope of the presently claimed dyes, and the exemplified basic dyes.

Applicant disagrees and respectfully traverses this rejection. Nevertheless, in order to advance prosecution, Applicant has amended the claims to further define the genus of cationic direct dyes which can be combined with nonionic guar gums to include only those dyes not covered by *Kao Corporation*. Specifically, Applicant has amended Claims 1 and 45 such that when said at least one cationic direct dye is chosen from compounds of formula (I) wherein both D's represent nitrogen atoms, hence forming an azo bridge,  $R_3$  and  $R'_3$  are simultaneously hydrogen atoms,  $R_1$  and  $R_2$  are simultaneously unsubstituted methyl groups, and A is  $A_6$  wherein  $R_4$  is an unsubstituted methyl group, or when said at least one cationic direct dye is chosen from compounds of formula (III) wherein D1 and D2 are simultaneously nitrogen atoms, m is zero,  $R_{15}$  is a hydrogen atom,  $R_{13}$  is a dimethyl amino radical, and E is  $E_8$  wherein R' is an unsubstituted methyl group, then the at least one thickening polymer is not chosen from nonionic guar gums. By these amendments, Applicant is no longer claiming dyes within the scope of *Kao Corporation's* disclosure.

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

Accordingly, because *Kao Corporation* fails to teach or suggest every element of the Applicant's invention as now claimed, the Examiner has not established a *prima facie* case of obviousness. Therefore, Applicant respectfully requests withdrawal of this rejection.

**Lang**

Claims 1-19, 25-31, 42-47 and 51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lang* (U.S. Pat. No. 3,985,499) for the reasons set forth on pages 8-9 of the present Office Action. The Examiner asserts that *Lang* teaches hair dyeing compositions which overlap in scope with those as claimed, e.g., the dyes of *Lang's* formula (IIA). Allegedly, *Lang's* Examples L, M and R contain polymers containing at least one sugar unit as claimed in the claimed amounts, and the Examiner cites particularly Examples K and L. (Applicants note that the Examiner probably meant L and M and have responded accordingly). The Examiner acknowledges, however, that *Lang's* dyes differ from those presently claimed of formula (I) in that they comprise an extra substituent on the pyridine ring, and cites Examples 50 and 51. The Examiner further admits that *Lang* does not exemplify a composition as claimed, particularly which contains both a polymer and dye as claimed, and further, that *Lang* does not teach the claimed dyeing methods wherein the oxidant is separately applied. The Examiner

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

concludes that it would have been obvious to substitute *Lang's* exemplified dyes of Examples K and L (L and M) with dyes of the present invention.

Applicant respectfully traverses this rejection. Nevertheless, in order to advance prosecution, Applicant has amended Claims 1 and 45 to further define that the genus of cationic direct dyes which may be combined with hydroxyalkylcelluloses or carboxyalkylcelluloses includes only those dyes not covered by *Lang*. Specifically, Applicant has amended Claims 1 and 45 such that when said at least one cationic direct dye is chosen from those of formula (I) wherein both D's represent nitrogen atoms, hence forming an azo bridge, and A is chosen from A<sub>13</sub>, or when said at least one cationic direct dye is chosen from those of formula (III) wherein both D<sub>1</sub> and D<sub>2</sub> each simultaneously represent nitrogen atoms, m is zero and E is E<sub>2</sub>, then said at least one thickening polymer may not be chosen from hydroxyalkylcelluloses and carboxyalkylcelluloses. By these amendments, Applicant is no longer claiming any compositions within the scope of *Lang's* disclosure.

Further, Applicant traverses the rejection of Claim 51. Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to use the compositions of *Lang* in a process comprising separately storing a first composition comprising at least one cationic direct dye as presently claimed and separately storing a second composition comprising at least one oxidizing agent as presently claimed and at least one thickening polymer as presently claimed. The Examiner has failed to provide

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

any evidence that such a process would be obvious to one of skill in the art and, therefore, Applicant asserts that a *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully asserts that this rejection is in error and should be withdrawn.

Accordingly, because *Lang* fails to teach or suggest every element of the Applicant's invention as now claimed, the Examiner has not established a *prima facie* case of obviousness. Therefore, Applicant respectfully requests withdrawal of this rejection.

VI. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our deposit account, Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: Thalia V. Warnement  
Thalia V. Warnement  
Reg. No. 39,064

Dated: February 13, 2001